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REMARKS

Claims 1-13 are pending. The Board has reversed the rejection of Claims 1-13 under 35 U.S.C. § 112, first paragraph, and entered new grounds of rejection under 37 C.F.R. § 1.196(b). Specifically, Claims 1-7 and 9 are rejected under 35 U.S.C. § 102(b) as anticipated by Curtin *et al.* and Claim 8 is rejected under 35 U.S.C. § 103(a) as obvious in view of Curtin *et al.*

Examiner's Interview

On May 23, 2004, Applicant's Attorney, Alice O. Carroll, Applicant's Agent Pamela A. Torpey, Examiner Padmanabhan and Primary Examiner Chen conducted a telephonic interview to discuss the Board of Appeal Decision and new grounds of rejection set forth in the Decision. Applicant, Applicant's Attorney and the undersigned, thank the Examiner and the Primary Examiner for their willingness to discuss the merits of the application and their helpful suggestions. Applicant respectfully requests a telephonic interview prior to issuance of a further office action.

Rejection of Claims 1-7 and 9 Under 35 U.S.C. § 102(b)

Claims 1-7 and 9 are rejected under 35 U.S.C. § 102(b) in view of Curtin *et al.*, *Amer. J. Med. Technol.*, 33(3)175-178 (1967). In the discussion of the rejection, the Board has failed to give any weight to the preamble and "wherein" clause of the Claims. In support of its decision regarding the preamble, the Board has cited *Pitney Bowes Inc. V. Hewlett Packard Co.*, 182 F.3d 1298 (1999). In citing *Pitney Bowes Inc.*, the Board relies merely on dicta, rather than the specific application of the law to the facts in the case. Applicant respectfully disagrees with the Board analysis regarding the claim construction, for the reasons set forth below.

The preamble is an introductory phrase that may summarize the invention, its relation to the prior art, or its intended use or properties. Claim preambles are construed consistently with the same claim construction principles used for other parts of a claim. In general, a preamble can limit the scope of a claim if it recites essential structure or steps or if it is "necessary to give life meaning and vitality" to a claim. *Catalina Marketing International, Inc. v. coolsavings.com Inc.* 289 F.3d at 808, 62 USPQ2d at 1784 (quoting *Pitney Bowes, Inc. V Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). If a claim preamble provides

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antecedents for ensuing claim terms, and goes beyond merely stating an intended use, for example, it can be found to be part of the description of the invention as a whole. Consider that in *Catalina Marketing International, Inc v. Coolsavings.com.*, it was held that a decision whether or not to treat a preamble as a limitation can be resolved upon review of the entire patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim. See also *Intirtool, Ltd. v. Texar Corp.*, No. 03-1394, at *9, 2004 U.S. App. LEXIS 9055 (Fed. Cir. May 10, 2004).

Griffin v. Bertina, 285 F. 3d 1029 (2002) reviews both the weight of the preamble and the effect of "wherein" clauses on claim construction for method claims similar in subject matter to the instant application. In *Griffin v. Bertina*, the court held that the preamble "has the import that the claim as a whole suggest for it", citing *Bell Communications Research v. Vitalink Communications Corp.*, 55 F.3d 615, 34 USPQ 2d 1816 (Fed. Cir. 1995).

Throughout the prosecution history, Applicant has repeatedly relied on the preamble of the claims and the Specification disclosure detailing the diagnostic meaning of the method steps. Reliance upon the preamble during prosecution to overcome prior art "transforms the preamble into a claim limitation". *Catalina v. Cool Savings.com*, 289 F.3d 808; also *Intirtool, Ltd. v. Texar Corp.*, No. 03-1394, at *10, 2004 U.S. App. LEXIS 9055 (Fed. Cir. May 10, 2004).

Also in the Decision, the Board improperly treats the "wherein" clause as if it were a "whereby" clause. While some decisions determined that "whereby" clauses are nonlimiting, *Griffin v. Bertina* discounts these cases as being fact specific. *Griffin v. Bertina* viewed the "wherein" clause as elaborating the meaning of the preamble and that the steps set forth have "little meaning or utility unless they are place within the context of the diagnosis..." *Id.* 1034. Thus, "wherein" clauses that relate back to and clarify what is required by the claim give meaning and purpose to the manipulative steps.

In view of the remarks above, Claims 1-7 and 9 are not anticipated by Curtin *et al.* because Curtin *et al.* fails to teach the use of the method steps in diagnosing or aiding in the diagnosis of a predisposition to psychosis. As set forth above, consideration of the preamble and wherein clause are necessary in the claim construction and must not be ignored. Reconsideration and withdrawal of the rejection are respectfully requested.

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Rejection of Claim 8 under 35 U.S.C. § 103(a)

Claim 8 stands rejected under 35 U.S.C. §103(a). Applicant respectfully disagrees. Claim 8 has been incorrectly construed similar to Claims 1-7 and 9 as discussed above. As discussed above, the preamble and wherein clauses of independent Claim 6 must be considered in the interpretation of Claim 8 and thus Curtin *et al.* fails to render the claim obvious for the reasons set forth above. Reconsideration and withdrawal of the rejections are respectfully requested.

Claims 10-13

These claims carry no outstanding rejections. While the Board did not expressly state they are allowable, no new rejection was made. Careful review of the language of Claims 10-13 indicates that the claims are directed to a method and kits for use in diagnosis of a predisposition to psychosis. Affording the necessary weight of the preamble as limiting the kit and method to the diagnosis of a predisposition to psychosis, these claims equally fall within the framework for claim construction detailed above and should be deemed allowable. Consideration on the merit of these claims is respectfully requested.

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CONCLUSION

In summary, it is believed that the claims are not anticipated by the cited art and are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Pamela A. Torpey
Pamela A. Torpey
Registration No. 45,736
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

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